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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,642	09/21/2000	Hu Yang	2039.008200	9201

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EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

43-18

Office Action Summary

Application No.

09/666,642

Applicant(s)

YANG ET AL

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 16, 38-40, 42, 67-69, 81-83, 85, 99-101 and 114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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All remaining rejections and/or objections follow.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bansleben et al. (USP 6,255,248) in view of Cahill et al. (USP 6,03585).

See the first Office action at the paragraph bridging pages 3 and 4 et seq.

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Claims 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 are rejected under 35 U.S.C. § 102(b) as being anticipated by Matthews et al. (USP 6,254,804), newly cited by applicants.

Matthews et al. disclose an oxygen scavenging composition for use with plastic materials containing a polymer having a cyclohexene functionality. Note the abstract. Note the Examples and in particular Example 11 in column 20 as well as Example 12 in column 20 wherein ethylene vinyl alcohol is transesterified with 3-cyclohexene-1 methanol and combined with ethylene vinyl alcohol (as in applicants' barrier polymer) and a benzophenone type photoinitiator and a cobalt metal catalyst and photolyzed.

The terminal disclaimer filed on 8-18-03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Application 09/595,410 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Applicants' arguments filed 8-18-03 have been fully considered but they are not deemed to be persuasive.

Applicants argue that the unit resulting from the polymerization of cyclopentene in the oxygen scavenging polymer would result from 1,3 insertion during copolymerization of the

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cyclopentene. However with regard to applicants' limitation of an "ethylenic backbone", it would appear to the Examiner that the presence of any $\text{CH}_2\text{-CH}_2\text{-}$ unit in a polymer results in a polymer which would be referred to as a polymer having an ethylenic backbone as the term appears to be used by applicants. Note in this regard that applicants' dependent claims such as for instance claim 67 even shows units containing heteroatoms or carbonyl groups in the backbone. Unpatented claims are given their broadest reasonable specification consistent with the specification and applicants' meaning of the term "ethylenic backbone" when viewed by those skilled in the art when viewing applicants' specification would be very broad considering the examples of materials having ethylenic backbones disclosed by applicants' specification. In any case even when using a rather narrow definition of the term "ethylenic backbone", a polymer containing some $\text{-CH}_2\text{-CH}_2\text{-}$ units could be said to have an ethylenic backbone. Applicants' claims do not exclude other units also present in the polymers of patentees such as propylenic units etc.

The above new grounds of rejection relying upon Matthews et al. was made after the submission of the reference by applicants

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and payment of a 1.17p fee and accordingly this action is being made FINAL, MPEP § 609.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey

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Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cdc

December 3, 2003

Jeffrey Mullis
Primary Examiner
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